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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/524,063	02/09/2005	Boris Mayer	30882/DP019	4442		
4743	7590	12/20/2007	EXAMINER			
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				MALONE, STEVEN J		
ART UNIT		PAPER NUMBER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/524,063	MAYER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	STEVEN J. MALONE	4127	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 February 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 18-22 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 18-22 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 February 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/9/2005, 3/14/2005</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. This communication is a first Office Action Non-Final rejection on the merits.

Claims 1-17 have been canceled and 18-22 are pending and have been considered below.

### ***Claim Objections***

2. Claims 19 and 21 are objected to because of the following informalities:

In claims 19 and 21 the abbreviations IDs and SMS should be spelled out for the first recitation found in the claims.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited limitation "the basis" in claim 18 at line 4 lacks proper antecedent basis.

The recited limitation "the orders" in claim 18 at lines 11, 13, 14, and 15 is unclear. Examiner does not know if "the orders" is referring to "notification orders" as

recited in claim 18 line 3 or "notification orders" as recited in claim 18 at line 9 or to an entirely different order such as second orders or second notification orders.

Claims 19-21 are indefinite because they depend on a claim that is indefinite.

The recited limitation "the specific users" in claim 22 at line 5 lacks proper antecedent basis.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 18-20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tilles et al. (6,748,295).**

**As per claim 18,** Tilles et al. discloses a method of transmitting notifications (information) to users of a logistic system, said logistic system comprising at least one parcel compartment system with at least one registered user, wherein notification orders are transmitted to a central sending component which, on the basis of the notification orders (parcel status), accesses at least one database and generates and sends appropriate notifications to the user (email or the like informing user of parcel status), the method comprising the steps of:

(a) calling up different modules (See the Abstract, via ActiveX software components) with associated functions in response to different events within the logistic system (See parcel status events or user events), said modules being selected from the group consisting of a client database (See col. 13 at lines 33-39, via a master server database), a registration unit (See col. 13 at lines 33-39, via user registration), and a system administration unit for the logistic system (See col. 6 at lines 25-28, via supervisor and manager system access);

(b) generating notification (“the transmission of information”, see paragraph 3 of the written description) orders by the modules (See col. 12 at lines 49-54, via internet email notifications);

(c)(i) transferring the notification orders (information orders) to the central sending component (master server 20 or web server 32, See col. 3 at lines 64-67) so the orders can be sent immediately (See col. 13 at lines 49-54, via sending an email when an item is placed in a storage compartment); or,

(ii) writing the notification orders into a communication request queue (a software instruction queue, see the Abstract, via application software; or a database used for queuing email notifications) so the orders can be sent in a deferred manner (See col. 12 at lines 55-59, via attaching a bar code to written notice of a failed delivery so the undelivered order can be scanned into a program queue allowing for electronic notification of the failed delivery); and reading the orders from the communication request queue (program instruction queue) by a queue reader (memory device) in a timer-controlled

manner (a scanner which includes a timer based central processing unit CPU or microprocessor) and transferring the orders to the central sending component (See col. 13 at lines 5-7, via an employee scanning a bar code related to a failed delivery for entry into a server database allowing email notice to be sent to a user);

(d) generating appropriate user-specific notifications by the central sending component (See col. 13 at lines 33-35, via user-specific email notifications); and,

(e) sending said notifications to the user by the central sending unit via a gateway (master server 20 or web server 32, see col. 3 at lines 64-67); wherein said generating step includes accessing at least one client database (See col. 13 at lines 33-36, via a master server database), a parcel database (See Figure 10 and col. 10 at lines 41-44, via local item inventory database), an automatic parcel delivery machine database (See Figure 11, via a carousel database 128), and a document database (See col. 10 at line 23, via database maintenance reports) by the central sending component (master server 20 or web server 32, See col. 3 at lines 64-67), wherein said method further includes the step of validating the status of the notification orders in a delivery contract logic before transferring the notification orders to the central sending component (See col. 13 at lines 31-54, via a user selecting delivery contract logic allowing mail to be delivered directly to a compartment system, the system checks (validates) to see if the contract option has been selected and notifies the user when compartment mail is available).

**As per claim 19**, Tilles et al. teaches the step of allocating client data, parcel data, and parcel compartment system data in the databases by means of IDs (See the Abstract, via customer identification so as to permit retrieval of items located in specifically designated bins; customer IDs being accessible by master server 20).

**As per claim 20**, Tilles et al. teaches wherein the events in the logistic system comprise at least the following:

- registration of the new user (See col. 13 at lines 33-39, via user registration)
- change in the user data (See col. 13 at lines 29-31, via taking a picture of the user when picking up an item)
- placement of a new parcel in a parcel compartment system (See col. 12 at lines 63-65, via loading of the storage unit)
- picking up a parcel from a parcel compartment system (See col. 13 at lines 8-9, via a user retrieving an item)
- sending back a parcel (See col. 10 at lines 66-67, via the return item function)
- adding a substitute for pick-up of a parcel (See col. 14 at lines 43-45, via a customer loyalty card transferable to a substitute for pick-up of a parcel).
- removing a substitute (See col. 14 at lines 43-45, via taking away a customer loyalty card from a substitute).

**As per claim 22**, Tilles et al. teaches a device for transmitting notifications to users of a logistic system that operates one or more parcel compartment systems (See col. 13 at lines 33-36, via transmitting email notifications to users when an item is stored in an item delivery and retrieval system IDRS), wherein the logistic system comprises

modules having functions for generating notification orders, of a central sending component, of a communication request queue (See col. 13 at lines 49-50, via when an item is placed in storage a notification is emailed), of a document database with templates for generating individual notifications for the specific users (See col. 13 at lines 49-50, via sending notification to a user based on an email address on file), of a client database with information about clients, of a parcel database with information about parcels (parcels present or not), of an automatic parcel delivery machine database (local item inventory database 134 or carousel database 128) with information about parcel Compartment systems and of a gateway for sending the notifications (See col. 13 at lines 49-54, via sending an email when an item is placed in a storage compartment), wherein the modules are one or more of a client database, a registration unit and a system administration unit for the logistic system (See col. 13 at lines 33-39, via a master server database).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tilles et al. (6,748,295) in view of Smith et al. (6,333,973).**

**As per claim 21,** Tilles et al. discloses all elements of the claimed invention but fails to disclose the step of sending the notifications to the users in the form of at least one of e-mail and SMS.

Smith et al. teaches an integrated message center including the step of sending the notifications to the users in the form of at least one of e-mail and SMS (See col. 8 at lines 1-10, via an SMS e-mail notification message).

From the teaching of Smith et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the item delivery and retrieval system of Tilles et al. to include an SMS message, an email message and/or an SMS email message as taught by Smith et al. in order to integrate different types of messages from different types of equipment.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Couch et al. (7,130,803) teaches a unique virtual dynamically-capable addressing system and method of mail and parcel delivery forwarding.

Thompson (7,158,941) teaches a residential and business logistics system and method.

Brandt el al. (7,081,595) teaches an apparatus and method for processing mailpiece information in a mail processing device using sorter application software.

Avant et al. (6,977,353) teaches an apparatus and method for identifying and processing mail using an identification code.

Bloom (6,974,928) teaches a method and apparatus for efficient package delivery and storage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. MALONE whose telephone number is (571)270-5107. The examiner can normally be reached on Monday-Thursday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/

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Primary Examiner, Art Unit 3627

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